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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,146	09/08/2003	Xavier Blin	05725.1239-00	1368

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EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

04/03/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/656,146

**Applicant(s)**

BLIN ET AL.

**Examiner**

JAMES W. ROGERS

**Art Unit**

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1.7-27.33-60.66-89.95-117 and 119-122 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1.7-27.33-60.66-89.95-117 and 119-122 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/09/2009 has been entered.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1,7,20,27,33,46,60,66,79,89,95,108 and 115-117 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically claims 1,27,60,89 and 115-117 all recite that the high viscosity phenyl siloxane oil is present in amounts ranging from 5 to 60%, the examiner could not find written support for this new limitation. Paragraph [0047] only states that the amount of phenyl siloxane oil can be from "10 to 60" which does not support the broader range of 5 to 60 as currently claimed. Furthermore claims 7,33,66 and 95 all recite the new

limitation the non-volatile ester oil is present in amounts ranging from 5-60%, there is no written support for this new limitation. Paragraph [0067] only states that the amount of hydrocarbon oil can be from "10 to 60" which does not support the broader range of 5 to 60 as currently claimed. Claims 20,46,79 and 108 all recite that the low viscosity phenylsiloxane oil is present in amounts ranging from 5 to 80%, there is no written support for this new limitation. Paragraph [0048] only states that the amount of hydrocarbon oil can be from "7.5" to "80" which does not support the broader range of 5 to 80 as currently claimed.

### ***Response to Arguments***

Applicants believe they have support for the ranges claimed above because the ranges 10 to 60% for the high viscosity phenylsiloxane oil and ester oil and 7.5 to 80% for the low viscosity phenylsiloxane oil are merely a preference and applicants expressly contemplated ranges that may vary within the wide range disclosed. Applicants rely on the case of *In re Wertheim* which they purport supports their case.

The examiner respectfully disagrees. In *Wertheim*, the application originally disclosed range of "25% to 60%" and examples at "36%" and "50%" (all per cents referring to the content of a compositional element). The examples at 36% and 50% are important, because they clearly showed that the Applicant had a preference for the upper part of that range, specifically the amount between about 35% and 60%. Note that this case is very different from applicant's current issue, notably applicants are not narrowing their range from a broad disclosure in the specification to a narrower value or data points from their own examples. Instead applicants are broadening their claimed

range from what is recited within the specification, for instance the high viscosity phenyl siloxane oil is present in amounts ranging from 5 to 60%, when the specific range in the specification is 10 to 60%. Applicants apply the value of 5 as their lower range when this value was clearly only contemplated for their broader recited range of 5 to 99%. Thus applicants are essentially picking and choosing the end points for their range when clearly those endpoints were concerned with two entirely different ranges.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

**Claims 1,7-27,33-60,66-89,95-117 and 119-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 5,961,998), for the reasons set forth in the previous office action filed 04/29/2008.**

**Claims 1,7-27,33-60,66-89,95-117 and 119-122 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 5,961,998) in view of Willemin et al. (US 6,592,855 B1, cited in previous office action), for the reasons set forth in the previous office action filed 04/29/2008.**

***Response to Arguments***

Applicant's arguments filed 03/09/2009 have been fully considered but they are not persuasive. Applicants assert that one skilled in the art would not have been motivated to arrive at the claimed invention by selecting one high viscosity phenylsiloxane oil and one non volatile ester oil in combination and Arnaud proved no preference for choosing these particular ingredients.

The relevance of this assertion is unclear. Simply because Arnaud discloses more than one type of phenylsiloxane oil does not mean that the high viscosity phenylsiloxane oils are not disclosed, in fact several of the phenylsiloxane oils are the same oils that applicants list in their specification as having the desired high viscosity such as PCR 15M30. Furthermore the reference clearly discloses that advantageously more than one type of oil is used and the secondary oils included synthetic esters such as diisostearyl malate. Lastly the same phenylsiloxane oil and ester oil tridecyl trimellitate are claimed in mixtures or combinations thereof, thus the two oils are within the claimed subject matter of the patent. "The prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed"... *In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004). Actually the examiner does not believe the question of obviousness or motivation to combine a high viscosity phenylsiloxane with an ester oil is relevant since Arnaud clearly teaches the use of both in mixtures with each other. Thus Arnaud actually teaches the limitation of a high viscosity phenylsiloxane oil in combination with an oil ester, the reference would be a 102 type of anticipatory reference if not for applicants claimed range, but this range as noted in the previous office action would have been obvious to optimize through routine experimentation.

Applicants further assert that the tests from the examples within the specification demonstrate the improvement of using high viscosity phenylsiloxane oil in combination with a non-volatile oil ester.

The examiner acknowledges the examples within the specification, however clearly as recited above Arraund does disclose the use of a phenylsiloxane in combination with an ester that is within applicants claimed scope. It is further noted that applicants examples are much narrower in scope than what is encompassed within the claims because a very specific ester oil and phenylsiloxane were used in the examples (diisostearyl stearate and phenyltrimethyltrisiloxane). Furthermore as noted above since Arnaud teaches mixtures of applicants same claimed high viscosity phenylsiloxane oil in combination with a non-volatile oil ester this argument would appear to not have much weight.

Applicants lastly assert that Arnaud merely discloses laundry list of phenylsiloxanes that may be used in the composition but nowhere states using both a high and low viscosity phenylsiloxane in combination. Applicants also assert that Willemin does not cure these deficiencies of Arnaud.

The examiner as pointed out in the last office action stated that Arnaud does describe some low viscosity phenylsiloxanes such as DC556 and high viscosity phenylsiloxanes such as PCR 15M30. As detailed previously Willemin describes low viscosity phenylsiloxanes were useful in cosmetic compositions. Thus one of ordinary skill in the art could have selected both a high and low viscosity phenylsiloxane oil simply because they were disclosed as being used for the same purpose and the addition would not change the respective functions of the oils within the composition. It is generally considered to be *prima facie* obvious to combine compounds each of which is taught by the prior art to be useful for the same purpose in order to form a

composition that is to be used for an identical purpose. The motivation for combining them flows from their having been used individually in the prior art, and from them being recognized in the prior art as useful for the same purpose. Cf. In re Kerhoven, 626 F.2d 848, 205 USPQ 1069 (CCPA 1980).

### **Conclusion**

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 9:30-6:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Michael G. Hartley/

Supervisory Patent Examiner, Art Unit 1618